



PATENT
Customer No. 22,852
Attorney Docket No. 05725.0974-00

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:)
Gilles RUBINSTENN et al.) Group Art Unit: 3689
Application No.: 10/024,333) Examiner: Gerardo Araque, Jr.
Filed: December 21, 2001) Confirmation No.: 4711
For: METHODS AND SYSTEMS FOR)
GENERATING A PROGNOSIS)

Attention: Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Appellants submit this Reply Brief under 37 C.F.R. § 41.41 to the Board of Patent Appeals and Interferences ("the Board"), in response to the Examiner's Answer, mailed December 7, 2009 ("Examiner's Answer"), in this case.

I. ARGUMENT

The Examiner has provided additional arguments, particularly with respect to the § 102 rejection of claims 31, 32, and 47, and the § 103 rejection of claims 1 and 48. Appellants respectfully submit the following remarks in response to the Examiner's new arguments.

A. The § 102(b) Rejection of Claims 31-36, 38-45, and 47 Should Be Reversed

In rejecting claims 31, 32, and 47 under 35 U.S.C. § 102, the Examiner asserts that "[i]f the prior art structure is capable of performing the intended use, then it meets the claim." Examiner's Answer at 16. Contrary to the Examiner's assertion, Linford does not disclose or suggest a "database . . ." and a "processor . . ." including all of the recitations of either claim 31 or claim 47, or a "means for maintaining . . ." and a "means for generating . . ." including all of the recitations of claim 32, and thus fails to teach every element of the claims.

With respect to claim 31, the Examiner cites a section of Linford (col. 5, lines 30-57) where it provides generic descriptions of a personal computer, I/O peripherals, video/image sources, and a modem. Examiner's Answer at 3-4. The Examiner asserts that these generic descriptions of a personal computer, I/O peripherals, video/image sources, and a modem teach every element recited in claim 31. Id. The Examiner is essentially asserting that because Linford discloses a personal computer and other external devices, every possible imaging technology system that runs on a computer is purportedly taught by Linford. This is incorrect.

The Examiner, in the Examiner's Answer, attempts to broaden the meaning of the term "database" beyond what those having ordinary skill in the art would understand the term to mean. Examiner's Answer at 16-17. As explained in more detail below, Linford does not disclose *any* database. Even the Examiner admits that "Linford . . . fails to disclose: maintaining, in a database, information of how use of at least one beauty product affects evolution of the external body condition." Examiner's Answer at 8.

To cure the acknowledged deficiency of Linford, the Examiner attempts to blur the distinction between data/information and computer instructions. Examiner's Answer at 16. For example, "[t]he Examiner asserts that in order for the user to manipulate the image to the desired outcome, the system must require data/information that instructs the system on how to carry out or perform the manipulation desired by the user." Id. Those having ordinary skill in the art would understand that computer instructions are distinctly different from data/information, and that it is computer instructions, not data, that instruct the system. Those having ordinary skill in the art also would understand that computer instructions would not necessarily be stored in a database. This understanding is also consistent with the figures and descriptions in the specification of the present application. For example, as shown in FIGS. 8A and 8B, it is Beauty Care Module 100 that includes instructions, not any of the databases. See page 24, line 11 - page 25, line 12.

The presence of computer instructions in the system does not necessarily mean that a database exists in the system, not to mention "a database for storing information on how use of at least one beauty product affects evolution of the external body

condition,” as recited in claim 31. Further, nowhere does Linford even suggest computer instructions using data/information stored in a database for manipulating images.

For example, Linford discloses “an aesthetic imaging system (20) for use in **editing** digital images.” Linford, Abstract (emphasis added). “The imaging program includes a unique combination **draw tool** that includes a **freehand draw** mode, a **curve** mode and an **undo mode** that are available without cycling through menus.” Id. (Emphasis added.) Thus, Linford discloses an image editing user interface for a user to make edits directly to images. In other words, the manipulations by the system of Linford are based on user inputs/instructions to draw lines and/or curves, and not based on “information on how use of at least one beauty product affects evolution of the external body condition,” which is stored in a database.

The Examiner, for the first time, alleges that the information that “the processor is using in the claims does not necessarily limit it to only information pertaining to the effects of using a beauty product, but any other information that may be stored in the database” because “information contained in the database” does not have “the” before the word “information.” Examiner’s Answer at 17. As explained above, because the Examiner has failed to establish that Linford discloses any database, and because Linford manipulates images in response to user inputs to draw lines and/or curves,

Linford fails to disclose “a processor for modifying the representation, based on information contained in [a] database . . . ,” as recited in claim 31.¹

For the reasons presented in the Appeal Brief, as well as the reasons outlined above, Linford does not support the § 102(b) rejection of claims 31-36, 38-45, and 47. Therefore, the § 102(b) rejection of claims 31-36, 38-45, and 47 based on Linford should be reversed.

B. The § 103(a) Rejection of Claims 1-30, 37, 46, and 48 Should Be Reversed

Proactiv shows nothing more than web pages containing text and graphics describing beauty products. The web pages themselves do not necessarily suggest the presence of a database. The Examiner has not presented any evidence as to how the web pages were created and/or generated, and without such evidence, the information described in the web pages cannot be said have come from a database. For example, static web pages containing information within the pages themselves in the form of text and graphics may be sitting on a web server, and upon request by a user, be sent to the user over the Internet without any involvement of a database. Those having ordinary skill in the art would appreciate the distinction between a web server and a database, and that a web server can present a web page to a user without the need for a database.

Even assuming, *arguendo*, that the text and graphics contained in the Proactiv web pages were to be stored in a database, nothing in Linford or Proactiv teaches or

¹ If the Board, however, finds that the claims would be allowable with the addition of “the” before the word “information,” Appellants respectfully submit that Appellants would be amenable to amending the claims in such a manner.

suggests that the text and graphics can be used, in any way, to generate at least one prognosis reflecting predicted changes in an external body condition after use of at least one beauty product. The information in text (e.g., sentences in paragraphs) and graphics, as shown in the web pages of Proactiv, are not structured in such a way that would be understandable by the system of Linford to generate at least one prognosis reflecting predicted changes in an external body condition after use of at least one beauty product. As explained above, Linford manipulates images in response to user inputs/instructions to draw lines and/or curves. Without conversion from the text and graphics as shown in the web pages of Proactiv into instructions to draw lines and curves that are understandable by the system of Linford, the combination of Linford and Proactiv is infeasible and would not be "generating . . . based on both the received representation and information contained in the database, at least one prognosis reflecting predicted changes in the external body condition after use of said at least one beauty product," as recited in claim 1.

For the reasons presented in the Appeal Brief, as well as the reasons outlined above, Linford does not support the § 103(a) rejection of claims 1-30, 37, 46, and 48. Therefore, the § 103(a) rejection of claims 1-30, 37, 46, and 48 based on Linford and Proactiv should be reversed.

II. CONCLUSION


For the reasons presented in the Appeal Brief, as well as the reasons outlined above, the Board is kindly requested to reverse all of the outstanding claim rejections so that pending claims 1-48 may be allowed.

To the extent that any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Reply Brief, such an extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 4, 2010

By: 
Anthony M. Gutowski
Reg. No. 38,742